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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10 088,121	07/25/2002	Edward A.Y. Fisher	LC-381-PCT-US	8094

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EXAMINER

MCAVOY, ELLEN M.

ART UNIT	PAPER NUMBER
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1764

DATE MAILED: 05/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/088,121

Applicant(s)

FISHER, EDWARD A.Y.

Examiner

Ellen M McAvoy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 25 July 2002 (prelim. amend.).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-5, 7-12 and 14-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-5, 7-12 and 14-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 7-12 and 14-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Apikos (4,416,788).

Apikos discloses a transparent lubricating oil composition useful as a high severity metal cutting oil which comprises a major amount of oil of high lubricating viscosity of about 50 SUS to about 1000 SUS at 100°F and minor amounts of at least one sulfur-containing compound and an effective amount of elemental sulfur. See column 1, line 28 to column 2, line 45. Apikos teaches that the sulfur containing compound may be any suitable compound soluble in lubricating oil at 40°F and which acts in combination with elemental sulfur to improve the extreme pressure properties of the composition. See column 2, line 46 to column 3, line 33. Elemental sulfur may be added to the composition in an amount of about 0.1 to about 1.5% by weight. This amount of active sulfur includes the amount of active sulfur applicant~~s~~ added to the examples in the application of 1.4 weight % which results in a Falax Extreme Pressure Test value of 4500+ and a Falax Wear Test of zero. The elemental sulfur component of Apikos also acts to improve the extreme pressure properties of the composition. See column 3, lines 34-48. The composition may also comprise at least one ester component as a lubricity agent. The ester component may be present in the composition in an amount of about 0.1 to about 10% by weight

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and suitable ester components include well known vegetable and fatty oils. See column 4, line 38 to column 6, line 2. Apikos teaches that other ingredients such as corrosion and rust inhibitors may be added to the composition. See column 6, lines 3-9. Thus, the examiner is of the position that Apikos clearly meets the limitations of components a), b), and c) of the claims. Applicant's open-ended claim language "comprising" allows for the addition of other additives to the composition such as the sulfur-containing compound of the prior art. The claimed properties of a Falax reference load of greater than 4,500 pounds, a Falax reference wear of less than 10 teeth, and a certain copper strip corrosion classification value are seen to be inherent properties of the composition. Although such properties are not set forth in Apikos, Apikos teaches a lubricant composition comprising the same components and suitable for the same purpose as does applicant, that is, for use as an extreme pressure lubricant in heavy duty applications such as metal working.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M McAvoy whose telephone number is (703) 308-2510. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (703) 308-6824. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Ellen M. McAvoy  
Primary Examiner  
Art Unit 1764

EMcAvoy  
May 19, 2003